

Applicant is canceling all of the claims in the application except for original claims 1-53 and method claims 54-59 and 64-65. These claims have been rejected under Section 251. The rejection of all of these claims is based upon the Examiner's contention that "the scope of the original filed claims 37 and 41 in the application correspond to the scope of the original filed claim 1." To the contrary, original claim 1 is an apparatus claim directed to an output buffer that includes a data coder and an output stage. Claim 37 is directed to a method of masking data having a total of 7 method steps, none of which are common to the 2 elements of claim 1. Claim 41 is directed to a method of selectively masking complementary read data signals having a total of 4 method steps, none of which are common to either the 2 elements of claim 1 or the 7 elements of claim 37. Thus, not only do claims 37 and 41 fail to correspond to claim 1, they do not even correspond to each other. Since the Section 251 rejections of claims 54-59 and 64-65 are based entirely on the purported correspondence of claims 37 and 41 to claim 1, the Section 251 rejections of these claims should be withdrawn.

Furthermore, as should be apparent to the Examiner, the output buffer of claim 1 is patentably distinct from the methods of claims 37 and 41 since the methods of claims 37 and 41 can be practiced by an apparatus that is different from the apparatus of claim 1, and the apparatus of claim 1 can operate in a manner that is different from the methods of claims 37 and 41. Therefore, in amending claim 1 to add the subject matter of claim 4 or the subject matter of other dependent claims, applicant may have surrendered the subject matter of claim 1. But in amending claim 1, applicant did not surrender the subject matter of method claims 54-59 and 64-65. Furthermore, independent claims 54, 58 and 64 are different from any of the method claims that were previously in the application insofar as they contain additional limitations. Therefore, even if applicant surrendered the subject matter of claims 37 and 41, he did not surrender the narrower subject matter of claims 54-59 and 64-65.

Although the MPEP does not specifically discuss whether is possible for a method claim to recapture the subject matter of an apparatus claim, the specific discussions in MPEP §1412.02 suggests that it is not. For example, the MPEP states in the section entitled "REISSUE FOR ARTICLE CLAIMS WHICH ARE FUNCTIONAL DESCRIPTIVE MATERIAL STORED ON A COMPUTER-READABLE MEDIUM:" indicates that is permissible to file a reissue application to cover article of manufacture claims for a computer-readable medium storing a computer program that performs a process even though the process was the subject matter of the prior application. Similarly, the section entitled "REISSUE TO TAKE

ADVANTAGE OF 35 U.S.C. 103(b)" indicates that a reissue application can be filed to obtain a claim directed to the process of making a composition even though claims to the composition were contained in the parent application. The rejection of claims 54-59 and 64-65 under Section 251 should therefore be withdrawn.

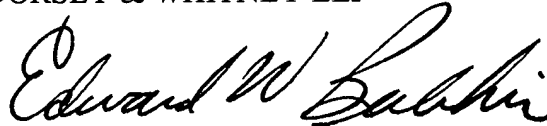
With respect to the other issues raised in the Office Action, applicant requests that the requirement for a new declaration be held in abeyance. Applicant will draft a new declaration and file it as soon as it can be reviewed and executed by the inventor.

The Examiner is correct that 37 CFR 1.174(c) requires that an amendment to the claims requires an explanation of the support in the disclosure of the patent for the changes made by the amendment. However, the claims remaining in this application have not been amended, so there is no requirement in Section 1.174(c) for any explanation of how changes made by amendment are supported by the specification.

The objection to claim 73 is now moot because of the cancellation of claim 73. Finally, applicant is requesting that Figures 2-4 be changed so that they are labeled "Prior Art."

Insofar as the claims remaining in this application, *i.e.* claims 1-59 and 64-65, should be allowed, favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,
DORSEY & WHITNEY LLP



Edward W. Bulchis
Registration No. 26,847

EWB:dms

Enclosures:

- Postcard
- Fee Transmittal Sheet (+ copy)
- Drawing Request Change (Figs. 2-4)
- Transmittal for Formal Drawings (Figs. 1-15)

1420 Fifth Avenue, Suite 3400
Seattle, WA 98101-4010
(206) 903-8800 (telephone)
(206) 903-8820 (fax)